

## **REMARKS / ARGUMENTS**

### **Status of Claims**

Claims 1-16 are pending in the application with claims 1-12, and 16-17 standing rejected and claims 13-15 being allowed by the Examiner. Applicant submits that claims 1 and 16 have been amended. Therefore claims 1-16 are left for consideration by the Examiner.

Applicant respectfully submits that in this fully responsive reply the rejections under 35 U.S.C. §103(a) have been traversed, no new matter has been entered, and the subject application is in condition for allowance. Therefore, reconsideration of the pending rejections and favorable allowance of the subject application are earnestly solicited.

### **Allowable Subject Matter**

Applicants thank the Examiner for indication that claims 13-15 contain allowable subject matter, and that they have been allowed.

### **Entry of Amendment After Final Rejection**

Applicants respectfully request entry of the amendments to claims 1 and 16 because they do not raise new issues and because they have been previously considered by the Examiner. The amendments do not raise new issues because the amendments have been previously argued in light of the specification in the response filed November 23, 2007 (see page 7). Furthermore, as noted in the pending Final Office Action (see page 5), “Applicants’ arguments filed 11/23/ 2007, have been fully considered” (emphasis added). Thus, Applicants respectfully request entry of the amendments to claims 1 and 16.

**Rejections Under 35 U.S.C. §103(a)**

**Claims 1, 2, 6, and 16**

Claims 1, 2, 6, and 16 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lee (U.S. Publication No. 2003/0016417 A1, hereinafter Lee) in view of Chevassus et al. (U.S. Patent No. 6,342,878, hereinafter Chevassus). Applicant respectfully traverses this rejection for the following reasons.

Lee and Chevassus, taken alone or in any combination, do not disclose or suggest “a gripping element housed within a casing, wherein the gripping element includes translation components and angular components relative to the casing” as recited in independent claim 1 (emphasis added).

Lee is directed to a wireless pointing and a briefing pointer device (see Lee, Abstract). Lee discloses a selection switch 15, located on a casing 1, to select between a first operating mode, a second operating mode, and a third mode described as a power-off mode (see Lee, para. [0030]-[0031]). Lee describes the first two modes as those of a conventional mouse and a conventional briefing pointer (see Lee, Abstract), with the device including a casing 1.

As set forth in Lee, the device casing 1 is the gripping element (see FIG. 5). Applicants do not concede that a casing only used as a gripping element anticipates or renders obvious a gripping element within a casing. Furthermore, to modify the teachings of Lee to include any features of a gripping element within a casing would destroy the intended purpose of Lee (see MPEP § 2143.01, “*If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification*”), particularly the intended purpose of the device being used as a briefing pointer ([0030-0031] and FIG. 5). More clearly, in order for the device to be used as a briefing pointer, the user must move the casing to adjust the pointer direction, with only the casing itself used as a gripping element. If the gripping element were within the casing, this operation would not be

possible.

Therefore, Lee does not disclose or suggest “a gripping element housed within a casing, wherein the gripping element includes translation components and angular components relative to the casing” as recited in independent claim 1 (emphasis added).

Furthermore, it is respectfully submitted that Chevassus fails to cure the deficiencies of Lee. Chevassus is directed to an input peripheral for a computer with automatic switching between three-dimensional (3D) and two-dimensional (2D) operating modes (see Chevassus, Abstract). Chevassus discloses that the input peripheral includes a casing which is the gripping element (see Chevassus, col. 2, ll. 29-39). For example, Chevassus clearly states that the “mobile casing [is] designed to be held by the user” (see Chevassus, col. 2, ll. 29-39).

Furthermore, modifying Chevassus to include any features of a gripping element within a casing would destroy the intended purpose of Chevassus (see MPEP § 2143.01, *“If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification”*), in particular, a mobile casing held by a user with a “means of detecting three dimensional position and rotation of the casing” (see Chevassus, col. 2, ll. 29-39, emphasis added). More clearly, in order for a user to move and rotate the casing within a 3-dimesional space as required by Chevassus, the casing must be used as the gripping element. If the gripping element were within the casing, this operation would not be possible.

Therefore, Chevassus cannot disclose or suggest “a gripping element housed within a casing, wherein the gripping element includes translation components and angular components relative to the casing” as recited in independent claim 1 (emphasis added).

Regarding claim 16, it is respectfully submitted that, similar to the arguments presented above, Lee and Chevassus fail to disclose or suggest “a gripping element housed within a casing, wherein the gripping element includes translation components and angular components relative to the casing” as recited in independent claim 16

(emphasis added). Therefore, claim 16 is patentable over Lee and Chevassus, alone or in any combination.

For all of the reasons given above, Chevassus and Lee, taken alone or in combination, do not disclose or suggest the limitations of claim 1 and 16. Furthermore, as argues above, any modification of Chevassus or Lee in an attempt to cure these deficiencies would destroy the intent of the references, thus Chevassus and Lee cannot be used to establish a *prima facie* case of obviousness, and the rejection must be withdrawn (see MPEP § 2143.01, "*If proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification*").

Claims 2 and 6 are also patentable, at least by virtue of their dependency upon independent claim 1.

Applicants respectfully request the Examiner to withdraw this rejection.

### **Claims 3-5**

Claims 3-5 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lee in view of Chevassus and further in view of Reid et al. (U.S. Patent No. 6,853,365, hereinafter Reid).

As argued above, Chevassus and Lee fail to disclose or suggest the limitations of independent claim 1. Furthermore, Applicant submits that even if Chevassus, Lee, and Reid were combinable (which Applicant does not admit), the resulting combination would still not disclose or suggest the limitations of claim 1, as Reid fails to cure the deficiencies of Chevassus and Lee discussed above.

Therefore, Applicant submits that claim 1 is patentable over Chevassus, Lee, and Reid, and that claims 3-5 are patentable at least by virtue of their dependency upon independent claim 1.

### **Claims 7-12**

Claims 7-12 stand rejected under 35 U.S.C. §103(a) as being unpatentable over Lee in view of Chevassus and further in view of Zagnoev (U.S. Publication No. 2003/0090394, hereinafter Zagnoev).

As argued above, Chevassus and Lee fail to disclose or suggest the limitations of independent claim 1. Furthermore, Applicant submits that even if Chevassus, Lee, and Zagnoev were combinable (which Applicant does not admit), the resulting combination would still not disclose or suggest the limitations of claim 1, as Zagnoev fails to cure the deficiencies of Chevassus and Lee discussed above. Therefore, Applicant submits that claim 1 is patentable over Chevassus, Lee, and Zagnoev, and that claims 7-12 are patentable at least by virtue of their dependency upon independent claim 1.

#### **Summary of Arguments of Pending Rejections**

In summary, Applicant respectfully submits that the obviousness rejection based on at least Chevassus and Lee is improper as the References fail to teach or suggest each and every element of the instant invention in such a manner as to perform as the claimed invention performs. For an obviousness rejection to be proper, the Examiner must meet the burden of establishing a *prima facie* case of obviousness. *In re Fine*, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). The Examiner must meet the burden of establishing that all elements of the invention are taught or suggested in the prior art. MPEP §2143.03. Furthermore, the proposed combination must not destroy the intended purpose(s) of the respective disclosures. MPEP § 2143.01.

Furthermore, as provided in Applicants' Response dated June 12, 2007, Chevassus discloses that the main purpose of Chevassus' disclosure is to provide automatic switching of modes, and therefore teaches away from the asserted combination of Chevassus and Lee, which as set forth by the Examiner, requires direct manual input to switch between modes (see Office Action dated August 23, 2007, page 3).

As such, the alleged combinations of Chevassus and Lee cannot properly be applied to establish a *prima facie* case of obviousness to support the pending rejections, and the pending rejections should be withdrawn.

### **CONCLUSION**

In view of above remarks, reconsideration of the outstanding rejections and allowance of pending claims 1-12, and 16 is respectfully requested. It is noted that claims 13-15 have been allowed.

If the Examiner believes that communication with Applicant's Representatives would assist in advancing this case to allowance, the Examiner is cordially invited to contact the undersigned so that any such issues may be promptly resolved.

The Commissioner is hereby authorized to charge any additional fees that may be required for this amendment, or credit any overpayment, to Deposit Account No. 06-1130.

In the event that an extension of time is required, or may be required in addition to that requested in a petition for extension of time, the Commissioner is requested to grant a petition for that extension of time that is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to the above-identified Deposit Account.

Respectfully submitted,

CANTOR COLBURN LLP

Applicant's Attorneys

By: 

John R. Sweet

Registration No: 59,770

Customer No. 23413

Address: 20 Church ST, 22nd Floor, Hartford, CT 06103  
Telephone: (860) 286-2929  
Fax: (860) 286-0115